

**PATENT**

Atty Docket No.: 200401879-1

App. Scr. No.: 10/767,285

**REMARKS**

Favorable reconsideration of this application is respectfully requested in view of the following amendment and remarks.

Claims 1-26 are pending in the present application, of which, Claims 1, 14, 18, 21, and 24 are independent. Dependent claim 23 had been amended due to a minor informality.

**Election of Species**

Claims 1-26 are subject to an election of species requirement (hereinafter referenced as "Requirement"). The election of species Requirement is traversed. The Examiner asserts that the present application contains claims that are directed to three patentably distinct species. As defined in the Office Action, these three alleged species are:

Species 1: "a method for determining a closest node to a given node," citing FIGS. 2 and 8 and paragraph [0074] of the published application;

Species 2: "a method for determining location information for a node in a network," citing FIG. 7 and paragraph [0068] of the published application;

Species 3: "a peer to peer system to store location information," citing FIGS. 9 and 10 and paragraph [0080] of the published application.

Alleged Species 1 corresponds to independent claims 1, 14 and 21 and dependent claims 7-13, 16, 17, 19, 22, 23 and 25. Alleged Species 2 corresponds to dependent claim 2, 4, 5 and 20. Alleged Species 3 corresponds to independent claims 18 and 24 and dependent claims 3, 6, 15 and 26. The Applicants elect alleged Species 1 with traverse.

The election is made with traverse because it is believed that all of the claims of this application can be examined at the same time without a serious search burden. Essentially,

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the search required for the non-elected Species 2 and Species 3 are believed to most likely be co-extensive with the search required for the elected Species 1 because, for example, patent applications classified in the same subclass require the same search. Here, the USPTO affirmatively classified all three alleged species into Subclass 225 of Class 709. See Exhibit A. Exhibit A is a print out from the USPTO's computer system ("public pair") that shows that the current and sole classification by the USPTO of the present application is Subclass 225 of Class 709. In addition, the Applicants respectfully submit that 1) the Examiner did not establish his burden of proof and 2) the Requirement is conclusory.

**1. The Examiner Did Not Establish His Burden of Proof.**

The MPEP § 808.02, titled "Establishing Burden," mandates:

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper (MPEP §806.05). If applicant voluntarily files claims to such related inventions in different applications, double patenting may be held.

Where the inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c)- MPEP §806.06, the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following:

(A) Separate classification thereof: This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) A separate status in the art when they are classifiable together: Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) A different field of search: Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered

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by the claims. Patents need not be cited to show different fields of search. Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.

The Examiner must explain why there is a serious search burden. See Id. However, the Examiner did not explain why there is a serious search burden. Here, the Examiner does not even allege that there would be a serious search burden. Thus, the Examiner has not established his burden of proof. Moreover, the only evidence of record shows that the USPTO has acted to classify the entire patent application in the same Subclass 225 of Class 709. See Exhibit A. Accordingly, the Applicants respectfully request withdrawal of the Requirement and examination of all claims for at least these additional reasons.

**2. The Requirement Is Conclusory.**

Under MPEP §808.01, "the particular reasons relied on by the examiner should be stated [and a] mere statement of conclusion is inadequate." Here, the Examiner must establish a serious burden by appropriate explanation of 1) separate classification, 2) evidence of separate status in the art, or 3) different field of search. The Requirement does not articulate a basis to show a "separate classification." For example, the Requirement does not establish that "each invention has attained recognition in the art as a separate subject for inventive effort and also a separate field of search." Emphasis added. (See MPEP §808.02 explaining how to show "separate classification.") As another example, Exhibit A shows that the USPTO classified the entire patent application in the same subclass or Subclass 225 of Class 709. In addition, the Requirement does not establish a "separate status in the art" such that "each invention can be shown to have formed a separate subject for inventive effort." For example, the Requirement fails to cite "patents which are evidence of such separate

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status.” (See MPEP §802.02 explaining how to show separate status in the art.) Moreover, the Requirement does not establish a “different field of search.” For instance, the Requirement does not even allege a different field of search. For any one of these independent additional-reasons, the Applicants respectfully submit that the Examiner’s arguments are conclusory. Thus, the Requirement fails to satisfy MPEP §808.01. Accordingly, the Applicants respectfully request withdrawal of the Requirement and examination of all claims for at least these additional reasons.

Essentially, the Requirement rests on three conclusory arguments at page 2, that 1) Species 2-3 are allegedly “not connected in at least mode of operation,” 2) “the Examiner has determined that the additional attributes present in Species 2 and 3 would not be an obvious variation of attributes present in Species 1,” and 3) “the Examiner had determined that the Species 1-3 differ in mode of operation from one another in ways that would not be obvious.” However, none of these three allegations are the three-prong test mandated under MPEP §808.02. Moreover, each of these three allegations independently fails to satisfy the requirements of MPEP §808.01 to state “the particular reasons relied on by the examiner [.]”

Regarding the Examiner’s first allegation that alleged Species 1, 2 and 3 are allegedly “not connected in at least mode of operation,” the Examiner cites FIGS. 2 and 8 and paragraph [0074] of the printed publication. See Requirement at page 2. However, it appears that neither of these figures nor the referenced disclosure supports a conclusion that Species 1, 2 and 3 are not connected in mode of operation. For example, because the description of alleged Species 2 and 3 reference the same description of FIG. 2 that the Examiner has found to be connected in mode of operation with alleged Species 1, it appears that all three alleged species are at least connected in mode of operation by FIG. 2. (Compare the description of

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alleged Species 2 at paragraph [0068] of the printed publication with the description of alleged Species 3 at paragraph [0080] of the printed publication.) For at least these additional reasons, the Applicants respectfully submit that the Examiner has not established his burden of proof under MPEP §808.02 to support the Requirement.

Regarding the Examiner's second of three allegations that he has made a determination of "additional attributes," the Examiner fails to support this allegation by specifically identifying these alleged "additional attributes." For at least this additional reason, the Applicants respectfully submit that the Examiner has neither established his burden of proof under MPEP §808.02 to support the Requirement nor satisfied the requirement of MPEP §808.01 to state "the particular reasons relied on by the examiner . . . ."

Finally, regarding the Examiner's third allegation that "the Species 1-3 differ in mode of operation from one another in ways that would not be obvious," it is unclear as to how this third allegation is different from the first allegation. In addition, the Examiner fails to support this third allegation. For at least these additional reasons, the Applicants respectfully submit that the Examiner has neither established his burden of proof under MPEP §808.02 to support the Requirement nor satisfied the requirement of MPEP §808.01 to state "the particular reasons relied on by the examiner."

**Complete Restriction Requirement under MPEP §§815 and 817**

Finally, the Applicants expect that the Requirement is a complete requirement as mandated under the MPEP and that no further requirement will be imposed on this application. If the Requirement is not complete, the Applicants respectfully traverse the Requirement further as also failing to comply with the mandates of MPEP §§815 and 817 and

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respectfully request that the Requirement be withdrawn and a new, complete requirement be issued.

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CENTRAL FAX CENTER****PATENT****AUG 21 2008**Atty Docket No.: 200401879-1  
App. Ser. No.: 10/767,285**Conclusion**

In light of the foregoing, withdrawal of the requirement and examination of all of the claims of this application are respectfully requested.

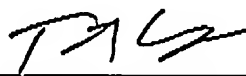
Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to this application, please contact the undersigned at the at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: August 21, 2008

By

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- Exhibit A -

10/767,285      Selecting nodes close to another node in a network using location  
information for the nodes      08-20-  
2008::20:03:18

**Bibliographic Data**

Application Number:	10/767,285	Customer Number:	-
Filing or 371 (c) Date:	01-30-2004	Status:	Non Final Action Mailed
Application Type:	Utility	Status Date:	07-18-2008
Examiner Name:	HAMZA, FARUK	Location:	ELECTRONIC
Group Art Unit:	2155	Location Date:	-
Confirmation Number:	4289	Earliest Publication No:	US 2005-0198286 A1
Attorney Docket Number:	200401879-1	Earliest Publication Date:	09-08-2005
Class / Subclass:	709/225	Patent Number:	-
First Named Inventor:	Zhichen Xu , San Jose, CA (US)	Issue Date of Patent:	-

Title of Invention:      Selecting nodes close to another node in a network using location  
information for the nodes

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- Exhibit A -